

Remarks

Claims 37-52 are pending. Claims 46-52 are newly added. No new matter has been added. The numbered paragraphs below correspond to the Examiner's numbered paragraphs.

1. Acceptance of the figures is acknowledged by the Applicants.

2. Applicants thank the examiner for the consideration of the information disclosure statement submitted on March 14, 2005. However, Applicants also filed an information disclosure statement on May 4, 2004 in compliance with the provisions of 37 C.F.R. § 1.97. Applicants respectfully request consideration thereof and return of the 1449 initialed by the Examiner.

3. Claims 37, 38, 40 and 42-44 have been rejected under 35 U.S.C. § 102(e) as being anticipated by LeBoeuf et al. (U.S. Patent No. 6,406,739). As correctly pointed out by the Examiner, LeBoeuf teaches coating ophthalmic lenses with materials such as polyhydroxyethyl methacrylate (poly(HEMA)) and polyvinyl pyrrolidone (PVP), followed by a two stage drying process. The first drying stage includes air drying followed by elevated temperature drying in a temperature range of 40-100 deg. C. Applicants respectfully disagree with and traverse the rejection on the following grounds:

First, a teaching of 40 to 100 deg. C. is not equivalent to a temperature greater than about the glass transition temperature. A glass transition temperature of a polymer depends on several factors including the molecular weight of the polymer, existence of additive or other moieties, among other factors. The mere disclosure of a generic class of polymers plus a temperature range of 40 to 100 deg. C. is not equivalent to teaching glass transition temperature of the

coating polymer. To state this argument more concretely by way of example, PVP, one of the listed polymers of LeBoeuf, can have a glass transition temperature of 180 deg. C. This temperature is dramatically above the disclosed temperature range of 40 to 100 deg C. There is absolutely no teaching in the reference that the temperature of the coating has to be equivalent or greater than the glass transition temperature of the polymer used.

Second, let us assume for argument's sake that LeBoeuf teaches a very specific brand of the listed polymers that happens to have a glass transition temperature somewhere between 40 and 100 deg. C. LeBoeuf merely teaches that the coating is exposed to elevated temperature between 40 and 100 deg. until the solvent is evaporated. This does not mean that the actual temperature of the polymer is elevated to be equivalent to or above the glass transition temperature as claimed. In other words, if a very volatile solvent is used, the solvent could evaporate well before the coating polymer reaches its glass transition temperature. Accordingly, Applicants submit that claim 37 is allowable over the cited reference. Claims 38, 40, 42, 43, and 44 depend from claim 37 and are allowable for at least the same reason. Removal of the rejection is respectfully requested.

4. Claims 37-39 and 41-45 have been rejected under 35 U.S.C. § 103(a) as being obvious over Berg et al. (U.S. Patent No. 5,464,650). The Examiner has indicated that although "the prior art does not teach heating of the polymer and the solution, it would have been obvious to one of ordinary skill the art at the time of the invention was made to employ any means necessary to evaporate the solvent from the solution (i.e., heat)." Applicants again respectfully disagree on the following grounds:

First, for a claimed range to be deemed *prima facie* obvious, the law clearly states that **there must be some overlap in the ranges or one range must lie inside the other.** In re

Wertheim, 541 F. 2d 257, 191 USPQ 90 (CCPA 1976). In the case at bar, there neither is an overlap nor does the claimed range lie inside what Berg has disclosed. In fact, the Examiner has admitted that Berg does not teach heating the polymer and solvent solution. Under the selection invention case law, the Examiner clearly has not established a *prima facie* case of obviousness.

Second, Applicants do not disagree with the Examiner that elevated temperatures will expedite the removal of a solvent of the coating composition. It would be ridiculous for the Applicants to argue to the contrary. However, heating at any elevated temperatures is not what the applicants are claiming. Applicants are claiming in claim 37 that the temperature of the polymer has to be elevated to be equivalent to or greater than its glass transition temperature. Applicants are specifically claiming a specific range that is not disclosed by the cited reference.

Third, as indicated before, even if a polymer is heated, this does not mean that the temperature of the polymer reaches its glass transition temperature. Again, when volatile solvents are used, the solvent may evaporate well before the glass transition temperature of the polymer is reached, obviating the necessity to further heat the device.

Fourth, again, the applicants are not claiming heating of the polymer to a temperature above room temperature, such as between temperatures of 25 to 50 deg. C. Applicants are specifically claiming that the temperature has to be equivalent to or greater than the glass transition temperature. The Examiner has addressed why elevated temperature would be obvious for solvent extraction, but has failed to state why one of ordinary skill in the art would be motivated to use a temperature that is equivalent to or greater than the glass transition temperature. To state this argument more concretely by way of example, if PVP has a glass transition temperature of 180 deg. C (as indicated above), why would one of ordinary skill in the

art use this temperature over another temperature? For evaporation of the solvent, why not heat to 135 deg. C? Considering how little solvent is used to coating intricate and delicate stent devices, such difference in temperature does not significantly affect how fast the solvent is removed so as to make the process much more attractive to one of ordinary skill in the art.

Accordingly, claim 37 is allowable over Berg. Claim 38, 39, 41, 42, 43 and 44 depend from claim 37 and are allowable for at least the same reason.

With respect to claim 45, Applicants are not clear as to the Examiner's position. Berg fails to teach an "inorganic polymer precursor" as recited by claim 45. The Examiner has failed to address this limitation.

Removal of the rejections and allowance of the claims is respectfully requested. Should the Examiner have any questions or concerns, the Examiner is invited to call the undersigned attorney of record.

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Respectfully submitted,

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